

### **REMARKS**

Claims 1 – 53 are pending in the application and are presented for a first substantive examination on the merits.

In the outstanding Office Action, claims 1 – 53 were subjected to a restriction requirement.

By this Response to Restriction Requirement, an election with traverse is made.

### **RESTRICTION REQUIREMENT SUMMARY**

The Examiner has required restriction of claims 1 – 53 under 35 U.S.C. §121 and §372. The Examiner alleges that the following groups of inventions are not linked to form a single general inventive concept under PCT Rule 13.1:

- |            |  |
|------------|--|
| Group I:   | claims 1-4, 11-36, and 50-52, drawn to a method of using a diagnostic marker(s) for diagnosing prostate cancer;  |
| Group II:  | claims 5-10, 37, drawn to a method of producing a medicament for the treatment of prostate cancer comprising at least one active substance which interacts with the protein annexin A3 and inhibits the activity and/or the abundance of the protein annexin A3; |
| Group III: | claims 38-49, drawn to a method for using an active substance for the treatment of cancer; and   |
| Group IV:  | claims 36 and 53, drawn to a method for seeking active substances for the treatment of cancer.   |

The Examiner also requires elections of species for a diagnostic marker: annexin A3; annexin A1; annexin A2; annexin A5; mitochondrial enoyl-coenzyme A hydratase; PDI; SAP; nuclear chloride ion channel protein; HES1; proteasome alpha 2-subunit; protein adenine-phosphoribosyl-transferase; inorganic pyrophosphatase; or proteins listed in claims 28 and 31. An election of species of activity is also required, as follows: upregulated or downregulated. Also a species of method of detection, as follows, is required: methods listed in claim 34.

If Group II is elected, a species of active substance elected from one listed in claims 6-8 must be further elected.

### **Response**

Applicants traverse the requirement but provisionally elect to continue prosecution of Group I, encompassing claims 1-4, 11-36 and 50-52, drawn to a method of using diagnostic markers for diagnosing prostate cancer. As the species for the diagnostic marker, Applicants elect annexin A3. As the species for activity, Applicants elect the down-regulation of cancer. As the species of method of detection, Applicants elect antibodies.

It is respectfully submitted that there is no serious burden to examine the claims of all the Groups. Under MPEP §803, “[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.” Regardless of any differences that may exist between the inventions set forth in the different claims, a complete and thorough search for the invention set forth in any one of the Groups would require searching the art areas appropriate to the other Groups. Due

to the similarity of the features of the Groups, a search for each of the inventions of the Groups would be coextensive and, therefore, it is respectfully submitted that it would not be a *serious* burden upon the Examiner to examine all of the claims in this application.

Moreover, given the overlapping subject matter of the Groups, examinations of all of the invention groups would not pose a serious burden because they would be coextensive. Further, the fact that various Groups may fall under different U.S. Patent and Trademark Office classes does not necessarily make them independent or distinct inventions. The classification system at the U.S. Patent and Trademark Office is based in part upon administrative concerns and is not necessarily indicative of separate inventive subject matter in all cases.

Further, Applicants have paid a filing fee for an examination of all the claims in this application. If the Examiner refuses to examine the claims paid for when filing this application and persists in requiring Applicants to file divisional applications for each of the groups of claims, the Examiner would essentially be forcing the Applicants to pay duplicative fees for the non-elected or withdrawn claims, inasmuch as the original filing fees for the claims (which would be later prosecuted in divisional applications) are not refundable.

In view of the foregoing, Applicants respectfully request that the Examiner reconsider and withdraw the restriction requirement, and to examine all of the claims pending in this application.

**CONCLUSION**

In light of the foregoing, Applicants submit that the application is in condition for a first substantive examination. If the Examiner believes the application is not in condition for substantive examination, Applicants respectfully request that the Examiner contact the undersigned attorney if it is believed that such contact will expedite the prosecution of the application.

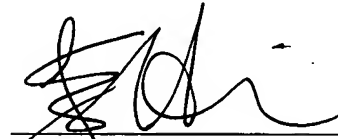
In the event this paper is not timely filed, Applicants petition for an appropriate extension of time. Please charge any fee deficiency or credit any overpayment to Deposit Account No. 14-0112.

Respectfully submitted,

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